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REMARKS

Claims 1-4, 6-10, 13-18 and 20-54 are pending. Claims 29-53 have been withdrawn. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1-4, 6-10, 13-18, 20-28 and 54 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,877,137, Rivette et al. ("Rivette '137") in view of U.S. Patent No. 6,389,434, Rivette et al. ("Rivette '434"). The applicant respectfully requests that this rejection be withdrawn for the following reasons.

The applicant's prior discussion of Rivette '137 and its deficiencies is expressly incorporated herein by reference.

The applicant previously presented arguments regarding example limitations which are neither taught nor suggested by Rivette '137. As one example, the applicant argued that "Rivette never combines the annotation data and the web page data into a single document. Rather, annotation data and document data are handled separately." Hence, the applicant argued that "Rivette fails to teach or suggest that the annotation data and the document data can be combined for form a single logical document with the annotation data embedded in the document data." (Amendment filed 22 September 2006, page 20, regarding independent claims 1, 18 and 25.)

Moreover, as another deficiency of Rivette '137 with regard to dependent claim 3, the applicants noted that Rivette does not provide a merge component further "configured to 'display the single logical document as a representation of the at least one document,' where the logical document includes the annotation data and the document data. To the contrary, Rivette provides for separate displays of the annotations and the web page." (Amendment filed 22 September 2006, page 22.) Rivette '434's annotations and the web page displays can be referenced by links.

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The examiner apparently concedes that the separate display does not constitute a single logical document, because the examiner does not respond to the express arguments with regard to claim 3.

The final office action admits that Rivette `137 "does not explicitly teach (C) at least one merge component configured to combine the annotation data and the document data to form a single logical document, the single logical [sic] having the annotation data embedded in the document data." To remedy this deficiency, the examiner cites Rivette `434.

Specifically, he argues that Rivette `434 teaches that notes can be "linked" to the documents, such as in Rivette `434 FIG. 2 illustrating a small icon 208 in an Excel cell 206 indicating that a note 212 is linked to the cell 206. The examiner posits that embedding a link in the document data is sufficient to meet the recited limitation. To the contrary, a document with a link to a note does not teach or suggest a "single logical document" with "the annotation data embedded in the document data." The examiner admits this when he admitted that Rivette `137 does not teach the merge component which forms the single logical document, because Rivette `137 teaches links to annotations. In fact, Rivette `434 appears to be merely cumulative of Rivette `137 on this point.

The examiner also cites Rivette `434's mention of the Microsoft OLE Programmers Reference, Volumes I and II, in Col. 9, lines 20-25 as being extremely relevant, but fails to make any portion of the OLE Programmers Reference of record. Therefore, the citation of Rivette `434, Col. 9, lines 20-25 appears to be completely irrelevant to the merge component. Furthermore, the examiner cannot rely on a reference which is not of record. If the examiner wishes to rely on this reference, he must make it of record and cite to the particular portion on which he relies.

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Finally, the examiner cites Rivette `434, Col. 14, lines 50 to Col. 15, line 15 as teaching an example "screen display" where the annotation data and the document data form a single logical document. Specifically, the examiner posts that displaying a screen where notes are displayed in separate windows from the document (e.g., FIG. 6A, 6B), and where the links are displayed to the side of the relevant text, teaches "a single logical document having the annotation data embedded in the document data." This portion of Rivette `434 references FIG. 6. Here, the "The user selects text 602, which is a portion of patent data object displayed in the application window 408. The notes application 302 instructs the application associated with the application window 408 to color code the selected text 602 using the same color as the pen 620, i.e., color 506. The notes application 302 creates a new note, called Note A, and displays Note A in a note window 606. ... The notes application 302 creates a new sub-note, called Sub-note A1, and displays Sub-note A1 in a sub-note window 610. The notes application 302 links Sub-note A1 to the selected text 602." (Col. 14, lines 46-57.) One can navigate to various notes and sub-notes in different window using linking buttons 604, 612. Notes and sub-notes can be grouped together, and a notes application 302 documents the trail through data objects 320 established by the linking mechanism 338. Patent applications, notes, and sub-notes are each displayed in separate windows. According to Rivette `434, a patent application is never merged with a note to form a single logical document. Similarly, a note is never merged with a sub-note to form a single logical document.

It is unclear whether the examiner considers Rivette `434's patent application and note, or note and sub-note to be the respective document data or annotation data. Regardless, because Rivette `434's patent application, note, and sub-note are displayed in separate windows, Rivette `434 fails to teach or suggest "the single logical document having the annotation data embedded in the document data."

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An alternative interpretation is that the examiner considers Rivette '434's patent

application and the links (rather than Rivette '434's annotation) to constitute the recited "single

logical document" because Rivette '434's patent application, notes, and sub-notes are stored

separately and are really never a single logical document (e.g., they appear in separate windows).

However, even under this interpretation the prima facie case is defective. That is, the links (e.g.,

FIG. 6A, element (604); FIG. 6B, element (612)) are not embedded in the document data. To the

contrary, they visually appear in the right side margin (FIG. 6A) or to the left below the

annotation (FIG. 6B); Rivette '434's links are never embedded in the document data.

Rivette '434 fails to teach or suggest that the annotation data and document data are

merged to form a single logical document, where the single logical document has the annotation

data embedded in the document data. To the contrary, Rivette '434 teaches that notes, subnotes,

and patent applications are each displayed in their own separate windows, and can be accessed

by traversing a link. (It appears that the examiner is relying on the inclusion of separate

windows on a single computer display as being a single logical document.) The proposition for

which the examiner cites Rivette '434 suffers from the same defects of Rivette '137 which it was

cited to cure.

Accordingly, the examiner has failed to make a prima facie case of obviousness with

respect to independent claims 1, 18 and 25.

Moreover, the examiner appears to be relying on a single computer display as being the

recited single logical document. According to the Doctrine of Claim Differentiation, a

dependent claim must further limit an independent claim. (E.g., 37 CFR 1.75; MPEP 608.01(n).)

Claim 1 recites, in combination,

"(C) at least one merge component configured:

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to retrieve the at least one document...,

to retrieve the at least one annotation..., and

to combine ..."

Claim 1 is the independent claim of claim 3, which recites that "the at least one merge component is <u>further</u> configured <u>to display</u> the single logical document." The examiner simply refers back to the explanation of claim 1 in supporting the rejection of claim 3, and cites nothing further. Hence, it appears that the examiner considers Rivette '434's display element as meeting both (1) the limitation that the merge component combines the annotation data and the document data (claim 1), and (2) the limitation that the merge component further displays the single logical document (claim 3). Due to the doctrine of claim differentiation, however, the combining is mutually exclusive of the displaying. The examiner apparently considers that claim 3 fails to further limit claim 1. This is incorrect. If the examiner maintains the rejection of claim 1 and 3, he is respectfully requested to particularly indicate the mutually exclusive elements of Rivette '434 which teach the display as recited in claim 3 as well as the combining as recited in claim 1.

Consequently, because of the doctrine of claim differentiation, the examiner's rejection of claims 1 and 3 must be withdrawn.

Similarly, under the principal of consistency, it is respectfully requested that the examiner's rejection of independent claims 18 and 25 be withdrawn. That is, the same terms appearing in independent claims 1, 18 and 25 must be given the same meaning. Claim 1, 18 and 25 all recite "at least one merge component configured: ... to combine the annotation data and the document data to form a single logical document, the single logical document having the annotation data embedded in the document data." The final office action merely incorporates the rejection of claim 1 into the rejections of claims 18 and 25 with regard to this limitation. Due to

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the doctrine of claim differentiation as outlined above, and the principal of consistency, the examiner's rejection of independent claims 18 and 25 must be withdrawn.

Independent claim 18 further recites in combination "at least one split component configured: to extract the annotation data and the document data from the single logical document, to update the at least one annotation in the first data storage from the extracted annotation data, and to update the at least one document in the second data storage from the extracted document data." Also, "the annotations which are to be applied to the document being stored in a first data storage, the documents being stored in a second data storage," wherein the first and second data storages are separate, the document is retrieved from the first data storage, and the annotation is retrieved from the second data storage. (See also dependent claim 7, which recites a split component.)

On the bottom of page 8, the examiner suggests that an electronic document with a hyperlink to another place in the same document or to an entirely different document is relevant. However, there is no explanation or any citation to a particular place in Rivette `137 regarding the use of hyperlinks. In any event, a document displayed with embedded links (whether hyperlinks or otherwise) does not teach or suggest a single logical document as recited, for the reasons further explained above.

The examiner cites Rivette `137's abstract as teaching the entire "split component" which extracts the annotation data and documentation data from the single logical document, as recited. According to Rivette `137's abstract, Web pages can be manipulated, stored at a Web site or in a local file system. Notes can be linked to Web pages by creating and linking an annotation to a selected portion of a Web page; the user can view "the selected portion linked to the annotation." Again, it is very evident that a display of a web page whereby a user can traverse a link to the

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annotation fails to teach or suggest a single logical document which has both the document and

the annotation embedded in the document data. Accordingly, it is not surprising that the

examiner neglected to even allege that any of the references teach or suggest "to extract the

annotation data and the document data from the single logical document." Consequently, Rivette

'137 fails to teach or suggest extracting both the web page (equated to the document data) and

the annotation data (equated to the annotation), in combination with updating the storage from

where the web page and the annotation were originally retrieved.

The examiner has failed to make a prima facie case of obviousness with respect to

independent claim 18 and dependent claim 7 for these additional reasons. Accordingly, claims 7

and 18 are deemed to be patentable over the references.

With regard to dependent claims 3-4, 7-10, 13, 15-16 and 23-24, the examiner

conveniently omits any citation to any reference to support the further limitations. The

Amendment filed 22 September 2006 explicitly addressed deficiencies in the rejection with

respect to dependent claims 3, 7, 9 and 16. Not only has the examiner not responded to the

applicant's express arguments with regard to dependent claims 3, 7, 9 and 16, the examiner's

failure to respond must be construed as a concession that the applicant's arguments are correct.

Therefore, the examiner must withdraw the rejection of claims 3, 7, 9 and 16. It follows that the

rejection of claim 1 (from which claims 3, 7, 9 and 16 depend) must also be withdrawn.

For at least these reasons, the combination of features recited in independent claims 1, 18

and 25, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In

addition, Rivette '137 and Rivette '434 fail to show other recited elements as well, as discussed

above.

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With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from allowable independent claims 1, 18 and 25, but also because of additional features they recite in combination.
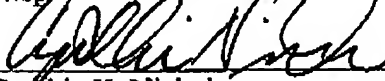
The applicant respectfully submits that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, the applicant has provided specific examples of elements in the claims that are clearly not present in the cited art.

The applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

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